

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1, 8, 11, 12, and 60 are pending in the present application. Claim 1 is amended and Claim 9 is canceled without prejudice by the present amendment.

In the outstanding Office Action, the Examiner requested that Applicants confirm that a telephone message indicating that a previous Office Action was in error was no later than December 28, 2004; Claims 1 and 60 were rejected under 35 U.S.C. § 103(a) as unpatentable over Yasuda et al. (U.S. Patent No. 6,221,455 B1, herein "Yasuda") in view of Honguh et al. (U.S. Patent No. 5,431,975, herein "Honguh"); Claim 8 was rejected under 35 U.S.C. § 103(a) as unpatentable over Yasuda, Honguh, and Matsushita (European Patent Application EP 0 626 682 A1); Claim 9 was rejected under 35 U.S.C. § 103(a) as unpatentable over Yasuda, Honguh, and Ueno et al. (U.S. Patent No. 5,234,737, herein "Ueno"); Claims 11 and 12 were rejected under 35 U.S.C. § 103(a) as unpatentable over Yasuda, Honguh, and Kikuchi et al. (U.S. Patent No. 4,711,821, herein "Kikuchi"); Claims 1, 8, and 60 were rejected under 35 U.S.C. § 103(a) as unpatentable over Yamaguchi et al. (U.S. Patent No. 6,205,092 B1, herein "Yamaguchi"), Honguh and the Applicant Background Art (herein "ABA"); Claim 9 was rejected under 35 U.S.C. § 103(a) as unpatentable over Yamaguchi, Honguh, ABA, and Ueno; Claims 11 and 12 were rejected under 35 U.S.C. § 103(a) as unpatentable over Yamaguchi, Honguh, ABA, and Kikuchi; Claims 1, 8, and 60 were rejected under 35 U.S.C. § 103(a) as unpatentable over Ohnuki et al. (U.S. Patent No. 6,160,769, herein "Ohnuki"), Hirokane et al. (U.S. Patent No. 5,648,162, herein "Hirokane"), and Honguh; Claim 9 was rejected under 35 U.S.C. § 103(a) as unpatentable over Ohnuki,

Hirokane, Honguh, and Ueno; and Claims 11 and 12 were rejected under 35 U.S.C. § 103(a) as unpatentable over Ohnuki, Hirokane, Honguh, and Kikuchi.

Initially, Applicants confirm that a message was left on December 28, 2004, on the Examiner's telephone to indicate that the Office Action of September 28, 2004, was in error.

Applicants thank Examiner Psitos for the courtesy of an interview extended to Applicants' representative on March 2, 2005. During the interview differences between the claims and the applied art were discussed. Further, claim amendments clarifying the claims over the applied art were discussed. The present response sets forth those discussed claim amendments. Examiner Psitos indicated that the discussed claim amendments appear to overcome the applied art and Examiner Psitos would further review a filed response. Arguments presented during the interview are reiterated below.

Applicants note that Information Disclosure Statements were filed on November 27, 2000, and April 9, 2004, which at this time have not been indicated as considered. A copy of the filed Information Disclosure Statements, the PTO-1449 forms, and the date-stamped Filing Receipts are submitted herewith for the Examiner's convenience. Applicants respectfully request the PTO-1449 forms be initialed as considered and returned with the next Office Communication.

Because the feature added to independent Claim 1 is identical to the feature of dependent Claim 9, which was already considered in the outstanding Office Action, entry of this amendment under 37 C.F.R. § 1.116 is believed to be in order and it is respectfully requested.

Regarding the outstanding rejections of Claims 1, 8, 9, 11, 12, and 60, Claim 1 is amended to recite the feature of Claim 9 and the outstanding rejections are traversed for the following reasons.

Briefly recapitulating, amended Claim 1 is directed to an optical recording medium that has, *inter alia*, a transparent heat radiating layer formed on a second protective layer and the transparent heat radiating layer has a heat conductivity higher than the second protective layer. The transparent heat radiating layer is a multi-layer film including a plurality of layers stacked together, having substantially the same optical constants and having different heat constants. In a non-limiting example, Figure 10 shows the transparent heat radiating layer 66 having the plurality of layers 66a-c.

As discussed and agreed during the interview, none of the applied art except Ueno discloses a protective film including a plurality of layers.

Thus, only Ueno is discussed next regarding amended Claim 1. Ueno shows in Figure 3 an optical recording medium having a protective film 2 that includes two layers with optical refractive indexes n_p and n_q , respectively. The refractive indexes are different from each other, which is contrary to amended Claim 1. Further, Ueno is silent about the layers of the protective film 2 having different heat constants as required by amended Claim 1. Furthermore, Ueno does not teach or suggest that the protective film 2 is formed on a second protective layer and has a heat conductivity higher than the second protective layer as required by Claim 1. Note that Ueno does not have a second protective layer between the recording layer 3 and the protective film 2.

Assuming arguendo that Ueno has a hypothetical second protective layer between the recording layer 3 and the protective film 2, because the hypothetical protective layer would be made of a similar material as the protective film 2 (see Ueno at column 3, lines 49-54, for materials used for a protective layer), the hypothetical protective layer and the protective film 2 would have the same heat conductivity, which is contrary to the claimed transparent heat radiating layer.

Accordingly, it is respectfully submitted that independent Claim 1 and each of the claims depending therefrom patentably distinguish over the applied art.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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(OSMMN 06/04)



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COPY

Serial/Patent/Reg. No. 09/1006,885 L&L File No. 3044 T0850 By: ~~AVS~~/KZF
In the Matter of the Application of: Yuji Kuroda et al
Title/Mark: Optical Recording Medium & Optical Recording & Reproduction Device
Date Mailed: November 27, 2000 Due Date:

The following has been received in the U.S. Patent and Trademark Office on the date stamped hereon:

<input checked="" type="checkbox"/> Transmittal Letter	<input type="checkbox"/> Trademark (Use) Appln., Drawing and _____ Specimens
<input type="checkbox"/> Patent Application _____	<input type="checkbox"/> ITU Trademark Application and Drawing
<input type="checkbox"/> _____ pgs. specification including _____ pgs. claims	<input type="checkbox"/> _____ Request for Extension of Time (trademark)
<input type="checkbox"/> Drawings _____ sheets _____ formal _____ informal	<input type="checkbox"/> (Notice of Allowance: _____)
<input type="checkbox"/> Oath/Declaration	<input type="checkbox"/> Statement of Use/Amendment to Allege Use
<input type="checkbox"/> Assignment w/ Form PTO-1595	<input type="checkbox"/> Section 8 & 15 Declaration
<input type="checkbox"/> Power of Attorney	<input type="checkbox"/> Trademark Renewal Application and _____ Specimen
<input type="checkbox"/> Small Entity Declaration	<input type="checkbox"/> Opposition to _____
<input checked="" type="checkbox"/> Deposit Account Authorization (in duplicate)	<input type="checkbox"/> Petition for Cancellation
<input checked="" type="checkbox"/> Information Disclosure Statement, PTO-1449 w/ 1 references	<input checked="" type="checkbox"/> Certificate of Mailing
<input type="checkbox"/> Check \$ _____	<input type="checkbox"/> Express Mail Certificate No. _____
<input type="checkbox"/> Amendment/Response	<input type="checkbox"/> Certificate under §3.73(b)
<input type="checkbox"/> Request for Extension of Time (____ months)(patent)	<input type="checkbox"/> Certificate of Correction (PTO Form 1050)
<input type="checkbox"/> Terminal Disclaimer	<input type="checkbox"/> Petition for _____
<input type="checkbox"/> Notice of Appeal	<input type="checkbox"/> Other: _____
<input type="checkbox"/> Appeal Brief (in triplicate)	_____
<input type="checkbox"/> Letter to Official Draftsman	_____
<input type="checkbox"/> Issue Fee Transmittal	_____
<input type="checkbox"/> Maintenance Fee Transmittal	_____
<input type="checkbox"/> Request for _____	_____



-1-

PATENT

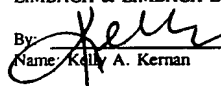
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	Group Art Unit: 2753
)	
YUJI KURODA ET AL.)	Examiner: Not Assigned
)	
Application No. 09/606,885)	<u>INFORMATION DISCLOSURE</u>
)	<u>STATEMENT</u>
Filed: June 29, 2000)	
)	2001 Ferry Building
For: OPTICAL RECORDING MEDIUM)	San Francisco, CA 94111
AND OPTICAL RECORDING AND)	(415) 433-4150
REPRODUCTION DEVICE)	

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on November 27, 2000.

LIMBACH & LIMBACH L.L.P. Date: November 27, 2000

By: 
Name: Kelly A. Kernan

Commissioner for Patents
Washington, D.C. 20231

COPY

Sir:

Applicants submit herewith patents, publications or other information [attached hereto and listed on the attached Form PTO-1449 (modified)] of which they are aware, which they believe may be material to the examination of this application and in respect of which there may be a duty to disclose in accordance with 37 CFR § 1.56.

This Information Disclosure Statement:

- (a) ☐ accompanies the new patent application submitted herewith. 37 CFR § 1.97(a).
- (b) ☐ is filed within three months after the filing date of the application or within three months after the date of entry of the national stage of a PCT application as set forth in 37 CFR § 1.491.

- (c) ☒ as far as is known to the undersigned, is filed before the mailing date of a first Office Action on the merits.
- (d) ☐ is filed after the first office action and more than three months after the application's filing date or PCT national stage date of entry filing but, as far as is known to the undersigned, prior to the mailing date of either a final rejection or a notice of allowance, whichever occurs first, and is accompanied by either the fee (\$240) set forth in 37 CFR § 1.17(p) or a certification as specified in 37 CFR § 1.97(e), as checked below.
- (e) ☐ is filed after the mailing date of either a final rejection or a notice of allowance, whichever occurred first, and the Issue Fee has not been paid, and is accompanied by the fee (\$130) set forth in 37 CFR § 1.17(i)(1) and a certification as specified in 37 CFR § 1.97(e), as checked below. This document is to be considered as a petition requesting consideration of the information disclosure statement.

[If either of boxes (d) or (e) are checked above, the following "certification" under 37 CFR § 1.97(e) may need to be completed.] The undersigned certifies that:

- (f) ☐ Each item of information contained in the information disclosure statement was cited in a communication mailed from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this information disclosure statement.
- (g) ☐ No item of information contained in this information disclosure statement was cited in a communication mailed from a foreign patent office in a counterpart foreign application or, to the knowledge of the undersigned after making reasonable inquiry, was known to any individual designated in 37 CFR § 1.56(c) more than three months prior to the filing of this information disclosure statement.

A list of the patent(s) or publication(s) is set forth on the attached Form PTO-1449 (Modified).

A copy of the items on PTO-1449 (Modified) is supplied herewith:

- (h) ☒ each (i) ☐ none (j) ☐ only those listed below:

A concise explanation of relevance of the items listed on form PTO-1449 (Modified) is:

- (k) ☒ not given
- (l) ☐ given for each listed item
- (m) ☐ given for only non-English language listed item(s)
[Required]
- (n) ☐ is in the form of an English language copy of a Search Report from a foreign patent office, issued in a counterpart application, which refers to the relevant portions of the references [copy attached].

The Examiner is reminded that a "concise explanation of the relevance" of the submitted items "may be nothing more than identification of the particular figure or paragraph of the patent or publication which has some relation to the claimed invention," MPEP § 609.

While the information and references disclosed in this Information Disclosure Statement may be "material" pursuant to 37 CFR § 1.56, it is not intended to constitute an admission that any patent, publication or other information referred to therein is "prior art" for this invention unless specifically designated as such.

In accordance with 37 CFR § 1.97(g), the filing of this Information Disclosure Statement shall not be construed to mean that a search has been made or that no other material information as defined in 37 CFR § 1.56(a) exists. It is submitted that the Information Disclosure Statement is in compliance with 37 CFR § 1.98 and MPEP § 609 and the Examiner is respectfully requested to consider the listed references.

- [x] The Commissioner is hereby authorized to charge our Deposit Account No. 12-1420 for any fees required in connection with the filing of this Information Disclosure Statement. **A duplicate copy of this Notice is enclosed for this purpose.** In particular, in the event that an Office Action has crossed in the mail with this Information Disclosure Statement, the Commissioner is authorized to charge the above-named deposit account for any fees required pursuant to CFR §§ 1.17(p) or 1.17(i)(1).

Respectfully submitted,
LIMBACH & LIMBACH L.L.P.

Dated: 11-27-00

By: 

Andrew V. Smith

Reg. No. 43,132

Tel. No. 415/433-4150

Our File: SONY-T0850 (S00P0850US00)



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PATENT

Sheet 1 of 1

FORM PTO-1449 (Modified) (Rev. 7-80)		U.S. Dept. of Commerce Patent and Trademark Office		Atty Docket No. SONY-T0850 (S00P0850US00)		Appln. No. 09/606,885	
INFORMATION DISCLOSURE CITATION (Use several sheets if necessary)				Applicant(s) YUJI KURODA ET AL.			
				Filing Date June 29, 2000		Group 2753	
U.S. PATENT DOCUMENTS							
*Examiner Initials		Document Number	Date	Name	Class	Subclass	Filing Date
	AA	5,253,313	10/12/93	KISHIMA	385	38	04/21/92
FOREIGN PATENT DOCUMENTS							
*Examiner Initials		Document Number	Date	Country	Class	Subclass	Translation YES NO
OTHER DOCUMENTS							
Examiner				Date Considered			
* Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.							

COPY



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13

OSMM&N File No. 203761US6

Serial No. 09/606,885

In the matter of the Application of: Yuji KURODA, et al.

For: OPTICAL RECORDING MEDIUM/SYSTEM WITH HEAT-DISSIPATING
AND LIGHT REFLECTING LAYERS

Dept.: IP-I

By: BDL/ams

Due Date: 04/14/04

The following has been received in the U.S. Patent Office on the date stamped hereon:

- Dep. Acct. Order Form
- Information Disclosure Statement
- Cited References (6)
- Search Report EUROPEAN
- PTO-1449



Docket No. 203761US6/ams

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Yuji KURODA, et al.

SERIAL NO: 09/606,885

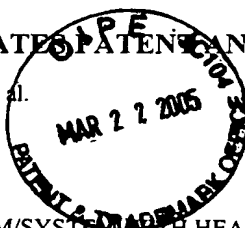
FILED: June 29, 2000

RCE FILED: January 21, 2004

FOR: OPTICAL RECORDING MEDIUM/SYSTEM WITH HEAT-DISSIPATING AND LIGHT REFLECTING LAYERS

GAU: 2653

EXAMINER: A. M. PSITOS



INFORMATION DISCLOSURE STATEMENT UNDER 37 CFR 1.97

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

COPY

SIR:

Applicant(s) wish to disclose the following information.

REFERENCES

- ☒ The applicant(s) wish to make of record the references cited in the attached European Search Report listed on the attached form PTO-1449. Copies of the listed references are attached, where required, as are either statements of relevancy or any readily available English translations of pertinent portions of any non-English language references.
- ☐ A check or credit card payment form is attached in the amount required under 37 CFR §1.17(p).

RELATED CASES

- ☐ Attached is a list of applicant's pending application(s) or issued patent(s) which may be related to the present application. A copy of the patent(s), together with a copy of the claims and drawings of the pending application(s) is attached along with PTO 1449.
- ☐ A check or credit card payment form is attached in the amount required under 37 CFR §1.17(p).

CERTIFICATION

- ☐ Each item of information contained in this information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this statement.
- ☐ No item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the undersigned, having made reasonable inquiry, was known to any individual designated in 37 CFR §1.56(c) more than three months prior to the filing of this statement.

DEPOSIT ACCOUNT

- ☒ Please charge any additional fees for the papers being filed herewith and for which no check or credit card payment is enclosed herewith, or credit any overpayment to deposit account number 15-0030. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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Form PTO 1449
(Modified)U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

ATTY DOCKET NO.

203761US6

SERIAL NO.

09/606,885

LIST OF REFERENCES CITED BY APPLICANT

APPLICANT

Yuji KURODA, et al.

FILING DATE June 29, 2000

PRCE FILED: January 21, 2004

GROUP

2653

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
	AA	6,333,900	12/25/2001	T. MARO, et al.			
	AB	5,368,908	11/29/1994	W. OHTA, et al.			
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						
	AL						
	AM						
	AN						

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION	
					YES	NO
	AO	0 365 333	04/25/1990	EUROPE		
	AP	WO 99/27532	06/03/1999	WIPO		
	AQ	0 984 443	03/08/2000	EUROPE		
	AR					
	AS					
	AT					
	AU					
	AV					

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, etc.)

	AW	Patent Abstracts of Japan, JP 11-007657, January 12, 1999				
	AX					
	AY					
	AZ					<input type="checkbox"/> Additional References sheet(s) attached

Examiner

Date Considered

*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.